

**Notice of Allowability**

Application No.

09/935,557

Examiner

Lori A. Clow, Ph.D.

Applicant(s)

GUNTHER, ERIK

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the RCE filed 28 august 2007.
2. ☒ The allowed claim(s) is/are 1-4,6-25 and 32-43.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application                      |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>8/28/07</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                    |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                  | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|   | 9. <input type="checkbox"/> Other _____.   |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 28 August 2007 has been entered.

### **Information Disclosure Statement**

The information disclosure statement (IDS) submitted on 28 August 2007 has been considered in full. A signed copy of PTO Form 1449 is included with this Office Action.

### **Examiner's Amendment**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Tina Quinton on 23 July 2007.

The application has been amended as follows:

In the specification:

1. At page 12, beginning line 3, replace

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“(see <http://www.ncbi.nlm.gov/SAGE/sagexp.cgi?grpB=166&grpB=167&grpA=171&grpA=172&FACT=2.0&CUTOFFA=0&CUTOFFB=0&nameA=Colon+caner&nameB=Normal+colon>)” with

--see the World Wide Web at ([ncbi.nlm.gov/SAGE/sagexp.cgi?grpB=166&grpB=167&grpA=171&grpA=172&FACT=2.0&CUTOFFA=0&CUTOFFB=0&nameA=Colon+caner&nameB=Normal+colon](http://ncbi.nlm.gov/SAGE/sagexp.cgi?grpB=166&grpB=167&grpA=171&grpA=172&FACT=2.0&CUTOFFA=0&CUTOFFB=0&nameA=Colon+caner&nameB=Normal+colon))--

2. At page 16, line 5 replace

“(<http://ra.rprc.washington.edu/microarray/Protocols/QiagenRNAprep.info.010108ks.htm>)” with

--see the World Wide Web at

([ra.rprc.washington.edu/microarray/Protocols/QiagenRNAprep.info.010108ks.htm](http://ra.rprc.washington.edu/microarray/Protocols/QiagenRNAprep.info.010108ks.htm))--

3. At page 16, line 12 replace

“([http://ra.rprc.washington.edu/microarray/Protocols/ProbeSynandHyb\\_010209ks.html](http://ra.rprc.washington.edu/microarray/Protocols/ProbeSynandHyb_010209ks.html))”

with

--see the World Wide Web at

([ra.rprc.washington.edu/microarray/Protocols/ProbeSynandHyb\\_010209ks.html](http://ra.rprc.washington.edu/microarray/Protocols/ProbeSynandHyb_010209ks.html))--

4. At page 16, line 17 replace

“(<http://ra.rprc.washington.edu/microarray/Genelists/Human/Human.htm>)” with

--see the World Wide Web at

([ra.rprc.washington.edu/microarray/Genelists/Human/Human.htm](http://ra.rprc.washington.edu/microarray/Genelists/Human/Human.htm))--

5. At page 17, line 8 replace

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“(http://promega.com/pnotes/75/8554\_10/8554\_10.pdf)” with

--see the World Wide Web at (promega.com/pnotes/75/8554\_10/8554\_10.pdf)--

6. At page 17, line 16 replace

“(http://ra.rprc.washington.edu/microarray/Presentations/Facilities/sldOO7.htm)” with

--see the World Wide Web at  
(ra.rprc.washington.edu/microarray/Presentations/Facilities/sldOO7.htm)--

7. At page 17, line 22 replace

“(http://ra.rprc.washington.edu/microarray/Presentations/Facilities/sldOO8.htm)” with

--see the World Wide Web at  
(ra.rprc.washington.edu/microarray/Presentations/Facilities/sldOO8.htm)--

### **Reasons for Allowance**

Claims 1-4, 6-25, and 32-43 are allowed.

Claims 22 and 25, previously withdrawn species, are hereby rejoined.

The following is an examiner's statement of reasons for allowance: the prior art does not teach or fairly suggest a method for identification of analytes in which a first expression profile is obtained from a biological assay; a second expression profile is obtained on a different set of molecules; a third expression profile is obtained from the second set after treatment with an analyte with **uncharacterized pharmacological activity** and the third profile is then compared to the first profile and second profile to identify analytes that induce the third profile that is more similar to the first than is the second profile similar to the first.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Inquiries**

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (571) 272-0715. The examiner can normally be reached on Monday-Friday from 10 am to 6:30 pm.

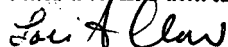
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

LORI A. CLOW, PH.D.

PRIMARY EXAMINER



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14 September 2007